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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/618,716

07/18/2000

Kyoji Saito

P19789

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7590

10/11/2006

GREENBLUM & BERNSTEIN, P.L.C.
1950 ROLAND CLARKE PLACE
RESTON, VA 20191

EXAMINER

LIN, KENNY S

ART UNIT

PAPER NUMBER

2152

DATE MAILED: 10/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/618,716	Applicant(s) SAITO, KYOJI	
	Examiner Kenny Lin	Art Unit 2152	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 30,31,35 and 36 is/are allowed.
- 6) ☒ Claim(s) 1-29,32-34 and 37-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>11/25/05</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 13-41 are presented for examination.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/26/2006 has been entered.

Allowable Subject Matter

3. Claims 30-31 and 35-36 are allowed. Reason of allowance can be found in previous office action.

Priority

4. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.
5. The effective filing date for the subject matter defined in the pending claims which have support in parent JP 11-321411 in this application is 11/11/1999. Any new subject matter defined in the claims not previously disclosed in parent JP 11-321411, is entitled to the effective filing date of 07/18/2000.

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6. Should applicant desire to obtain the benefit of foreign priority under 35 U.S.C. 1 19(a)-(d) prior to declaration of an interference, a translation of the foreign application should be submitted under 37 CFR 1.55 in reply to this action.

7. As stated in previous office action and also in paragraphs 3-4, the effective filing date for the subject matter defined in the pending claims which has support in parent JP 11-321411 in this application is 11/11/1999. Any new subject matter defined in the claims not previously disclosed in parent JP 11-32141 1, is entitled to the effective filing date of 07/18/2000. Should applicant desire to obtain the benefit of foreign priority under 35 U.S.C. 1 19(a)-(d) prior to declaration of an interference, a translation of the foreign application should be submitted under 37 CFR 1.55. Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15. Since the applicant decline to provide translation of the foreign priority paper as evidence in proving support of subject matter claimed in foreign application, the subject matter claimed in this application is only entitled to the effective filing date of 7/18/2000 until proven. Therefore, Iwazaki is a valid reference.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 13-15, 20-22, 27 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Toyoda et al (Toyoda), US 5,812,278, in view of Paul, US 5,999,932.
10. Toyoda was cited in the previous office action.
11. As per claim 13, Toyoda taught the invention substantially as claimed including an image receiving apparatus comprising:
 - a. A transmitter configured to transmit an e-mail with data attached, via a computer network (col.3, lines 20-23, col.15, lines 8-19);
 - b. A receiver configured to receive an e-mail with data attached, via a computer network (col.3, lines 20-23);
 - c. A controller configured to convert the attached data into image data (col.1, lines 42-61, col.7, lines 59-63, col.15, lines 30-37);
 - d. The controller further being configured to judge whether or not the received e-mail includes a predetermined character string, the e-mail being related to an e-mail transmitted by the image receiving apparatus based on whether or not a header of the received e-mail includes a predetermined character string, and judged that the header of the received e-mail includes the predetermined character string or not (col.27, lines 50-56).

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12. Toyoda did not specifically teach to draw conclusion that the e-mail is an error mail if the header of the received e-mail is judged to include the predetermined character string, the predetermined character string being related to a sender of the error mail. Paul taught to determine and filter error e-mail (unsolicited e-mail) by comparing the e-mail addresses to a list of blocked sender e-mail addresses (col.1, lines 43-49). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Toyoda and Paul because Paul's teaching of to compare sender e-mails with a block list enables Toyoda's apparatus to determine and filter error mails by checking e-mail headers.

13. As per claim 14, Toyoda and Paul taught the invention substantially as claimed in claim 13. Toyoda further taught the image receiving apparatus further comprise a printer configured to print the image data, wherein the controller, when an error mail is detected, abstracts predetermined information from the e-mail, and converts the abstracted predetermined information into image data, and the printer prints the converted image data (col.1, lines 43-61, col.19, lines 24-50, col.20, lines 3-52).

14. As per claim 15, Toyoda and Paul taught the invention substantially as claimed in claim 13. Toyoda further taught the image receiving apparatus to further comprise a printer configured to print image data, where in the controller, when an error mail is detected, abstracts predetermined information from the e-mail, edits the abstracted predetermined information, and converts the edited information into image data, and the printer prints the converted image data (col.1, lines 43-61, col.19, lines 24-50, 57-61, col.20, lines 3-52).

15. As per claims 20-22, the method corresponds directly to the image receiving apparatus of claims 13-15, and thus these claims are rejected with the same rationale.

16. As per claim 37, Toyoda and Paul taught the invention substantially as claimed in claim 13. Toyoda further taught that the transmitter transmits the e-mail with data attached via a server (POP server 16, col.10, lines 46-52), and the predetermined character is set in the header of the received e-mail by the server (POP server automatically insert sender address in the sender field of the header).

17. As per claim 40, Toyoda and Paul taught the invention substantially as claimed in claim 13. Paul further taught the controller being configured to compare a character string in the header with a list of character strings to determine if the character string in the header is the predetermined character string (block list, col.1, lines 43-49).

18. Claims 16-19, 23-27, 32, 38-39 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Toyoda et al (Toyoda), US 5,812,278, in view of Paul, US 5,999,932, Praitis et al (Praitis), US 6,594,697 and Mori, US 6,417,930.

19. Praitis and Mori were cited in the previous office action.

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20. As per claims 16, Toyoda taught the invention substantially as claimed including an image receiving apparatus receiving an e-mail, the e-mail including a header and a body, the body including a message, the message including an image data part (figs. 6-7), the image receiving apparatus comprising:

- a. A transmitter configured to transmit an e-mail with data attached, via a computer network (col.3, lines 20-23, col.15, lines 8-19);
- b. A receiver configured to receive an e-mail with data attached, via a computer network (col.3, lines 20-23);
- c. A controller configured to convert the attached data to image data (col.1, lines 42-61, col.7, lines 59-63, col.15, lines 30-37); and
- d. The controller further being configured to search for a predetermined information, the e-mail being related to an e-mail transmitted by the image receiving apparatus (col.27, lines 50-56).

21. Toyoda did not expressly teach for a predetermined image data fixed code in the image data part of the e-mail of the body of e-mail and to judge that the received e-mail is an error mail when the predetermined image data fixed code is detected. Paul taught to determine error e-mail by comparing the e-mail message in the body of the e-mail with stored data (col.4, lines 12-24). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Toyoda and Paul because Paul's teaching of to compare e-mails messages content with stored data enables Toyoda's apparatus to determine error mails by checking e-mail message in the e-mail body. Praitis taught a controller for searching a

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predetermined data code in the data part of the electronic message and to judge that the received message is an error message, the electronic message being related to a message request transmitted by the receiving apparatus, when the predetermined data code is detected (abstract, figs. 2-3, 5-7, col.9, lines 10-22, 34-51). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the apparatus of Toyoda and Paul with the teachings of Praitis to include the searching of data code in an electronic message structure in order to provide a more efficient method of identify the related error since the server often create a returned message response having error information in the header and in the body of the message (Praitis, col.9, lines 18-22). Toyoda, Paul and Praitis did not expressly teach a multi/part structure electronic message having a predetermined data fixed code. Mori taught a network facsimile apparatus having a receiver configured to receive e-mails and a controller fro searching a predetermined image data fixed code [boundary code] in the image data part of the e-mail when the receiving e-mail is a multi-part structure (figs. 5, 7 10AA, col.11, lines 25-34, col.13, lines 40-57). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combined apparatus of Toyoda, Paul and Praitis with the teachings of Mori to include the searching of image data fixed code in a multi-part mail structure in order to provide a more accurate method of identified error mail since header information are trivial to fake or unavailable and image data fixed code is often present in multi-part mail structure (Mori, figs. 5, 7).

22. As per claim 17, Toyoda, Paul, Praitis and Mori taught the invention substantially as claimed in claim 16. Mori further taught the controller to search for the predetermined image

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data fixed code in the whole received e-mail when the received e-mail is a single-part structure, and judges that the received e-mail when the received e-mail is a single-part structure, and judges that the received e-mail is an error mail when the predetermined image data fixed code is detected (fig.7, col.11, lines 25-34, col.13, lines 40-57).

23. As per claim 18, Toyoda, Paul, Praitis and Mori taught the invention substantially as claimed in claim 17. Toyoda further taught a printer configured to printer image data, wherein the controller, when a error mail is detected, abstracts predetermined information from the e-mail, and converts the abstracted predetermined information into image data, and the printer prints the converted image data (col.1, lines 43-61, col.19, lines 24-50, col.20, lines 3-52).

24. As per claim 19, Toyoda, Paul, Praitis and Mori taught the invention substantially as claimed in claim 17. Toyoda further taught a printer configured to print image data, wherein the controller, when an error mail is detected, abstracts predetermined information from the e-mail, edits the abstracted predetermined information, and converts the edited information into image data, and the printer prints the converted predetermined image data (col.1, lines 43-61, col.19, lines 24-50, lines 57-61, col.20, lines 3-52).

25. As per claim 23-26, the method corresponds directly to the image receiving apparatus of claims 16-19, and thus these claims are rejected under the same rationale.

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26. As per claim 27, the apparatus corresponds to the image receiving method of claims 16 and 23, and thus is rejected under the same rationale.

27. As per claim 32, the method corresponds directly to the image communication apparatus of claim 27, and thus is rejected under the same rationale.

28. As per claim 38, Toyoda, Paul, Praitis and Mori taught the invention substantially as claimed in claim 16. Toyoda further taught that the predetermined image data fixed code is set in the image data part of the body of the e-mail by the image communication apparatus (attached, col.15, lines 8-19).

29. As per claim 39, Toyoda, Paul, Praitis and Mori taught the invention substantially as claimed in claim 27. Toyoda further taught the transmitter transmits the e-mail to which data is attached, via the server (POP server 16, col.10, lines 46-52), a predetermined header fixed message being set in a header of the transmitted e-mail by the image communication apparatus (col.27, lines 50-56).

30. As per claim 41, Toyoda, Paul, Praitis and Mori taught the invention substantially as claimed in claim 16. Paul further taught the controller being configured to compare an image data fixed code in the image data part of the body of the e-mail with a stored list of image data fixed codes to determine whether the image data fixed code in the image data part is the predetermined image data code (stored data, col.4, lines 12-24).

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31. Claims 28-29 and 33-34 rejected under 35 U.S.C. 103(a) as being unpatentable over Toyoda, Paul, Praitis and Mori as applied to claims 27 and 32 above, and further in view of Iwazaki, US 6,687,742.

32. Iwazaki was cited in the previous office action.

33. As per claim 28, Toyoda, Paul, Praitis and Mori taught the invention substantially as claimed in claim 27. Toyoda, Paul, Praitis and Mori did not expressly teach the predetermined header fixed message comprises [X:mailer:] field. Mori suggested exploration of art and/or provided a reason to modify the image receiving apparatus with other header fields (fig.7, col.7, lines 50-62, col.11, lines 25-34, col.19, lines 30-35). Iwazaki taught a predetermined header fixed message to comprise [X:mailer:] field (fig.5, col.6, lines 28-38, col.7, lines 27-50). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combined apparatus of Toyoda, Paul, Praitis, and Mori to include the [X:mailer:] field in header parsing feature since it would be preferable to include all identification data needed to determine the status of incoming mail. Most users preferred to implement header parsing based upon additional list categories, such as the "TO", "FROM", "MESSAGE-ID", "CONTENT-TYPE" e-mail headers as well as other headers (Mori, col.7, lines 57-62, col.13, lines 40-57).

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34. As per claim 29, Toyoda, Paul, Praitis and Mori taught the invention substantially as claimed in claim 27. Toyoda, Paul, Praitis and Mori did not expressly teach the predetermined image data fixed code comprises SUqk. Iwazaki taught the predetermined image data fixed code to comprises SUqk (fig.9). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combined apparatus of Toyoda, Paul, Praitis, and Mori to include the SUqk fixed code as a type of encoding method to encode the image message.

35. As per claims 33-34, the method corresponds directly to the image receiving apparatus of claims 29-29, and thus are rejected under the same rationale.

Response to Arguments

36. Applicant's arguments with respect to claims 1-41 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

37. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Greenstein, US 6,266,692.

Dieterman, US 6,393,464.

Aronson et al, US 6,654,787.

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38. A shortened statutory period for reply to this Office action is set to expire THREE MONTHS from the mailing date of this action.

39. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenny Lin whose telephone number is (571) 272-3968. The examiner can normally be reached on 8 AM to 5 PM Tue.-Fri. and every other Monday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on (571) 272-3913. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ksl
October 3, 2006

A handwritten signature in black ink, appearing to read 'Kenny Lin', followed by a large, stylized 'Z' or checkmark-like flourish.